

of the computer-pointing device; and

a second illumination apparatus, said second illumination apparatus generating light when the computer-pointing device is in a second operating mode, the light generated by said second illumination apparatus providing for the user a visual indication of the second operating mode of the computer-pointing device.

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5 cont.

R E M A R K S

Claims 1-21 are amended. Re-examination and reconsideration are requested.

To facilitate entry of the amendments, please find attached hereto a marked-up version of the changes made to the specification, abstract, and claims by the current amendment. The attached page is captioned "Version with Markings to Show Changes Made."

In the office action, paper number 3, dated January 15, 2003, the examiner objected to the drawings under 37 C.F.R. §1.83(a) as failing to show the time-delayed shut-off switch. The examiner objected to claim 1 as containing a minor typographical error. The examiner rejected claims 1-4, 6, 8, 10, 11, 13, and 15-21 under 35 U.S.C. §102(e) as being anticipated by Adan, et al., U.S. Patent No. 6,172,354 (Adan). The examiner objected to claims 5, 7, 9, 12, and 14 as being dependent on a rejected base claim, but indicated they would be allowable if rewritten to include the limitations of the base claim and any intervening claims. Applicant respectfully traverses the examiner's rejections for the reasons that will be set forth below.

Re the Specification and Abstract:

The "Summary of the Invention" and Abstract are amended to make them consistent with the amendments to the claims. No new matter is introduced.

Re the Claims:

The claims are amended to include the revisions and limitations indicated for each claim. Support for the revisions is provided in the specification at least at p. 4, l. 22 - p. 5, l. 7; p. 8, l. 14-21; p. 9, l. 11-19; p. 12, l. 30 - p. 13, l. 4.

Re the Objection to the Drawings:

The examiner objected to the drawings under 37 C.F.R. §1.83(a) as failing to show a "time-delayed shut off switch" as set forth in claim 9.

Applicant respectfully traverses this objection in that the feature in question, i.e., the time-delayed shut off switch is a minor variation of the invention, thus exempt from the requirements of 37 C.F.R. §1.83(a). See MPEP 608.02(f) which states, in part: "This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts." In the present application, the time-delayed shut off switch is a minor variation of the invention which may be incorporated in certain embodiments. See, for example, the description provided on page 11, lines 17-26 of the present application.

Because the time-delayed shut off switch is a minor variation of the invention, it is exempt from the requirements of 37 C.F.R. §1.83(a), as expressly set forth in MPEP 608.02(f). Therefore, applicant respectfully requests the examiner to remove the objection. In view of applicant's traversal of the objection, applicant does not submit at this time any changes to the drawing figures.

Re the Objection to Claim 1:

The examiner objected to claim 1 as containing a minor informality. The noted informality is corrected in the amendments to claim 1. Therefore, applicant believes this objection to be overcome.

Legal Standard For Rejecting Claims
Under 35 U.S.C. §102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

Argument:

Re The Rejections of Claims 1-4, 6, 8, 10, 11, 13, and 15-21:

The examiner rejected claims 1-4, 6, 8, 10, 11, 13, and 15-21 under 35 U.S.C. §102(e) as being anticipated by Adan for the reasons set forth in the office action. However, in light of the amendments to the claims, these rejections are now moot and will not be discussed in further detail herein.

With regard to the claims now pending, amended claim 1 is directed to a computer-pointing device having at least a first illumination apparatus wherein "the light generated by the first illumination apparatus provides for a user a visual indication of the first operating mode of the computer-pointing device" and second illumination apparatus wherein "the light generated by the second illumination apparatus provides for the user a visual indication of the second operating mode of the computer-pointing device." These limitations are not met by Adan in that the light sources utilized in Adan are not visible to the user, thus cannot "provide for a user a visual indication" of any operating mode

of Adan's operator input device. Accordingly, Adan cannot anticipate amended claim 1.

Dependent claims 2-17 are at least allowable over Adan in that they depend from claim 1, which is allowable over Adan.

5 Amended independent claim 18 is directed to a method that involves at least providing a computer-pointing device with first and second illumination apparatus wherein the illumination of the first illumination apparatus provides for a user "a visual indication of the first operating mode of the computer-pointing device" and wherein the illumination of the second illumination apparatus provides for the user "a visual indication of the second operating mode of the computer-pointing device." These limitations are not met by Adan in that the light sources utilized in Adan are not visible to the user, thus cannot
10 "provide for a user a visual indication" of any operating mode of Adan's operator input device. Accordingly, Adan cannot anticipate amended claim 18.

Dependent claim 19 is at least allowable over Adan in that it depends from claim 18, which is allowable over Adan.

20 Amended independent claim 20 is directed to a computer-pointing device that comprises at least "means for providing a user a first visual indication that the computer-pointing device is in a first operating mode" and "means for providing a user a second visual indication that the computer-pointing device is in a second operating mode." Again, these limitations are not met
25 by Adan because Adan's light sources are not visible to the user, thus cannot provide for a user "a visual indication" of any operating mode of Adan's operator input device. Accordingly, Adan cannot anticipate amended claim 20.

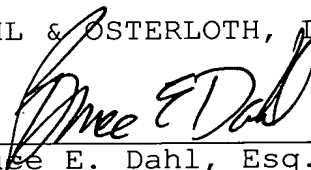
30 Amended independent claim 21 is directed to a computer-pointing device having at least first illumination apparatus wherein "the light generated by the first illumination apparatus provides for a user a visual indication of the first operating mode of the computer-pointing device" and second illumination
35 apparatus wherein "the light generated by the second illumination

apparatus provides for the user a visual indication of the second operating mode of the computer-pointing device." These limitations are not met by Adan in that Adan's light sources are not visible to the user, thus cannot "provide for a user a visual indication" of any operating mode of Adan's operator input device. Accordingly, Adan cannot anticipate amended claim 21.

Applicant believes that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicant respectfully requests the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicant's attorney at the telephone number listed below.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
BOHN, David, D.) Examiner: Nguyen, F.N.
Serial No. 09/900,211) Group Art Unit: 2674
Filing Date: July 6, 2001) Conf. No.: 6278
For: METHOD AND APPARATUS FOR) Atty. Dkt.: 10003357-1
INDICATING AN OPERATING)
MODE FOR A COMPUTER)
POINTING DEVICE)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Abstract:

The abstract on page 21 is amended as follows:

[Operating mode indicator apparatus for a] A computer-pointing device may comprise a first illumination apparatus and a second illumination apparatus. The first illumination apparatus is operatively associated with the computer-pointing device and generates light when the computer-pointing device is in a first operating mode. The second illumination apparatus is operatively associated with the computer-pointing device and generates light when the computer-pointing device is in a second operating mode.

In the Specification:

The paragraph on page 2, lines 4-10 is amended as follows:

[Operating mode indicator apparatus for a] A computer-pointing device may comprise a first illumination apparatus and a second illumination apparatus. The first illumination apparatus is operatively associated with the computer-pointing device and generates light when the computer-pointing device is in a first operating mode. The second illumination apparatus is operatively associated with the computer-pointing device and

generates light when the computer-pointing device is in a second operating mode.

The paragraph on page 2, lines 11-18 is amended as follows:

Also disclosed is a method [for indicating an operating mode
5 of a computer-pointing device] that comprises [the steps of]:
providing [the] a computer-pointing device with a first
illumination apparatus and a second illumination apparatus;
determining whether the computer-pointing device is in a first
operating mode; illuminating the first illumination apparatus if
10 it is determined that the computer-pointing device is in the
first operating mode; determining whether the computer-pointing
device is in a second operating mode; and illuminating the second
illumination apparatus if it is determined that the computer-
pointing device is in the second operating mode.

15 In the Claims:

Claims 1-21 are amended as follows:

1. (Amended) [Operating mode indicator apparatus for a]
A computer-pointing device, comprising:

20 a first illumination apparatus operatively associated
with the computer-pointing device, said first
[illuminating] illumination apparatus generating light when
the computer-pointing device is in a first operating mode,
the light generated by said first illumination apparatus
providing for a user a visual indication of the first
25 operating mode of the computer-pointing device; and

a second illumination apparatus operatively associated
with the computer-pointing device, said second illumination
apparatus generating light when the computer-pointing
device is in a second operating mode, the light generated
30 by said second illumination apparatus providing for the
user a visual indication of the second operating mode of
the computer-pointing device.

2. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, wherein the computer-pointing device comprises a mouse.

3. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, wherein said first illumination apparatus comprises a light-emitting diode, and wherein said second illumination apparatus comprises a light-emitting diode.

4. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, wherein said first illumination apparatus generates light having at least one attribute different than the light generated by said second illumination apparatus.

5. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, wherein said first illumination apparatus generates light when the computer-pointing device is not being moved, and wherein said second illumination apparatus generates light when the computer-pointing device is being moved.

6. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, further comprising a third illumination apparatus operatively associated with the computer-pointing device, said third illumination apparatus generating light when the computer-pointing device is in a third operating mode, the light generated by said third illumination apparatus providing for the user a visual indication of the third operating mode of the computer-pointing device.

7. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 6, wherein said first illumination apparatus generates light when the computer-pointing device is not in contact with [a] the user, wherein said second illumination apparatus generates light when the computer-pointing

device is being moved, and wherein said third illumination apparatus generates light when the computer-pointing device is in contact with the user but the computer-pointing device is not being moved.

5 8. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, further comprising a switch, said switch allowing [a] the user to disable the operating mode indicator apparatus.

10 9. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, further comprising a time-delayed shut off switch, said time-delayed shut off switch causing the operating mode indicator apparatus to be shut off after a period of inactivity.

15 10. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 1, further comprising a user detection device operatively associated with the computer-pointing device, said user detection device detecting when [a] the user is accessing the computer-pointing device.

20 11. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 10, wherein said user detection device comprises an optical sensor.

 12. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 10, wherein said user detection device comprises a thermal sensor.

25 13. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 10, wherein said user detection device comprises a mechanically activated switch.

30 14. (Amended) The [operating mode indicator apparatus] computer-pointing device of claim 10, wherein said user detection device comprises a capacitance proximity sensor.

15. (Amended) The [operating mode indicator apparatus]
computer-pointing device of claim 1, further comprising a data
processing system operatively associated with the computer-
pointing device, said data processing system receiving a data
5 signal from the computer-pointing device that is indicative of
the operating mode of the computer-pointing device, said data
processing system processing the data signal so that said first
illumination apparatus generates light when the computer-pointing
device is in the first operating mode and so that said second
.10 illumination apparatus generates light when the computer-pointing
device is in the second operating mode.

16. (Amended) The [operating mode indicator apparatus]
computer-pointing device of claim 1, further comprising a control
system, said control system actuating said first illumination
15 apparatus when the computer-pointing device is in the first
operating mode, said control system actuating said second
illumination apparatus when the computer-pointing device is in
the second operating mode.

17. (Amended) The [operating mode indicator apparatus]
20 computer-pointing device of claim 1, wherein said first
illumination apparatus and said second illumination apparatus
comprise a single illumination apparatus.

18. (Amended) A method [for indicating an operating mode
of a computer-pointing device], comprising:

25 providing [the] a computer-pointing device with a
first illumination apparatus and a second illumination
apparatus;

determining whether the computer-pointing device is in
a first operating mode;

30 illuminating said first illumination apparatus if it
is determined that the computer-pointing device is in the
first operating mode, the illumination of the first
illumination apparatus providing for a user a visual

indication of the first operating mode of the computer-pointing device;

determining whether the computer-pointing device is in a second operating mode; and

5 illuminating said second illumination apparatus if it is determined that the computer-pointing device is in the second operating mode, the illumination of the second illumination apparatus providing for the user a visual indication of the second operating mode of the computer-pointing device.

19. (Amended) The method of claim 18, further comprising: providing the computer-pointing device with a third illumination apparatus;

15 determining whether the computer-pointing device is in a third operating mode; and

illuminating said third illumination apparatus if it is determined that the computer-pointing device is in the third operating mode, the illumination of the third illumination apparatus providing for the user a visual indication of the third operating mode of the computer-pointing device.

20. (Amended) [Operating mode indicator apparatus for a] A computer-pointing device, comprising:

25 means for [indicating] providing for a user a first visual indication that the computer-pointing device is in a first operating mode; and

means for [indicating] providing for the user a second visual indication that the computer-pointing device is in a second operating mode.

30 21. (Amended) A computer-pointing device, comprising:

a cursor movement control device, said cursor movement control device allowing a user to move a cursor on display apparatus operatively associated with the computer-pointing

device;

5 a first illumination apparatus, said first illumination apparatus generating light when the computer-pointing device is in a first operating mode, the light generated by said first illumination apparatus providing for a user a visual indication of the first operating mode of the computer-pointing device; and

10 a second illumination apparatus, said second illumination apparatus generating light when the computer-pointing device is in a second operating mode, the light generated by said second illumination apparatus providing for the user a visual indication of the second operating mode of the computer-pointing device.